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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86285538
Applicant	Rockwell Automation, Inc.
Applied for Mark	RAPID LINE INTEGRATION
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Submission	Appeal Brief
Attachments	Appeal Brief for Rockwell Automation Inc., RAPID LINE INTEGRATION Trade-mark.pdf(689656 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:	
Serial No.:	86/285538
Mark:	RAPID LINE INTEGRATION
International Class:	Class 9
Applicant:	Rockwell Automation, Inc.
Filing Date:	May 19, 2014
Examining Attorney:	Barbara Rutland Law Office 101
Applicant's Attorney of Record:	Elisabeth Townsend Bridge

APPEAL BRIEF OF THE APPLICANT

On May 10, 2016, Rockwell Automation, Inc., ("Applicant"), filed its Notice of Appeal with the Trademark Trial and Appeal Board (the "TTAB") of the Examining Attorney's final refusal to register the mark RAPID LINE INTEGRATION ("Applicant's Mark"), with "LINE INTEGRATION" disclaimed. Registration was finally refused by the Examining Attorney under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Sec. 1052 on the basis that the Applicant's Mark is merely descriptive of the features and subject matter of the goods provided under the Applicant's Mark. Pursuant to the Notice of Appeal, the Applicant hereby appeals the Examining Attorney's final refusal to register the above-identified mark, and respectfully requests that the TTAB reverse the Examining Attorney's refusal and approve Applicant's Mark for publication and registration.

FACTS

On May 19, 2014, Applicant filed an application for registration of the mark "RAPID LINE INTEGRATION" for use on or in connection with "computer software for use in industrial

automation namely, application software and operator interface software for in manufacturing lines and equipment control," in International Class 9 (the "Applicant's Goods").

The Examining Attorney initially refused registration under Section 2(d) of the Trademark Act on the basis that, in her opinion, the Applicant's Mark was likely to cause confusion with the mark in U.S. Registration No. 4,072,266 for RAPID for use on "computer hardware, computer software, computer programs, all of the above goods relating to the collection, storage and analysis of production data in the field of production and manufacturing management for the manufacturing industry," in International Class 9 (the "Registered Mark").[1] The Examining Attorney also issued a requirement that the Applicant disclaim the wording "LINE INTEGRATION" because, in her opinion, the wording merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of the Applicant's Goods.[2]

Applicant responded to the initial Office Action on February 24, 2015, by arguing that the Applicant's Mark was unlikely to cause public confusion with the Registered Mark in light of (1) the significant distinctions in sound, meaning and appearance between the marks in their entireties; (2) the significant distinctions between the overall commercial impression of each mark; (3) the significant distinctions between the goods sold under the respective marks; (4) the frequent use of the word "rapid" in marks owned by third parties showing a crowded field of "rapid" marks; and (5) the level of sophistication and discrimination exhibited by consumers of goods sold under the respective marks.[3] Supportive evidence was submitted with the Response. Applicant also disclaimed the wording "LINE INTEGRATION" in accordance with the

[1] September 12, 2014 Office Action, TSDR p. 1.
[2] September 12, 2014 Office Action, TSDR p. 1.
[3] February 24, 2015 Response to Office Action, TSDR pp. 2–15.

Examining Attorney's requirement. Thus, Applicant's Mark includes the words "RAPID LINE INTEGRATION" with "LINE INTEGRATION" disclaimed.

After receipt of Applicant's initial response, on April 14, 2015, the Examining Attorney issued a second Office Action withdrawing the refusal under Section 2(d) of the Trademark Act and raising a new refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052 on the basis that the Applicant's Mark is merely descriptive of the features and subject matter of the goods provided under the mark.[4]

Applicant responded to the second Office Action on October 14, 2015, by arguing that the Applicant's Mark (1) is not descriptive of the Applicant's Goods, but is instead at least suggestive and distinctive and therefore registrable on the Principal Register; (2) is a double entendre that conveys a dual meaning and is thus not merely descriptive; and (3) the use of the word "rapid" in marks owned by third parties in the computer software and other contexts is frequently deemed at least suggestive by the U.S. Patent and Trademark Office (the "USPTO") and therefore Applicant's Mark should be treated similarly to those marks.[5] Supportive evidence was submitted with the Response.

After receipt of Applicant's second response, on November 30, 2015, the Examining Attorney issued a third Office Action maintaining and making final the Section 2(e)(1) refusal to register the Applicant's Mark on the basis that the Applicant's Mark is merely descriptive of the features and subject matter of the Applicant's Goods provided under the mark.[6] A Notice of Appeal was subsequently filed by Applicant and this Appeal Brief is now filed by Applicant pursuant to 37 C.F.R. Section 2.142(b)(1).

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[4] April 14, 2015 Office Action, TSDR p. 1.
[5] October 14, 2015 Response to Office Action, TSDR pp. 1–8.
[6] November 30, 2015 Office Action, TSDR p. 1.

ARGUMENT

I. Standard for Analysis of Section 2(e)(1) Cases

Applicant respectfully asserts that, in accordance with the legal standard for analysis of Section 2(e)(1) refusals, the Applicant's Mark is not merely descriptive of Applicant's Goods, but is, in fact, at least suggestive and distinctive, and therefore registrable on the Principal Register.

In order to be refused registration under Section 2(e)(1) of the Trademark Act, a mark must be ***merely*** descriptive of the applicant's goods or services. TMEP § 1209(b). A mark is descriptive if it ***immediately*** describes an ingredient, characteristic, quality or feature of the goods. *See Chicago Reader, Inc. v. Metro College Publishing Co.*, 222 USPQ 782 (7th Cir. 1983). On the other hand, a mark is suggestive if ***imagination, thought and perception*** on the part of the purchaser are required in order to obtain some direct description of the applicant's goods or services or the purpose for which they are sold. *McCarthy on Trademarks and Unfair Competition*, § 11:67; *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 160 USPQ2d 177 (SDNY 1968). The mental leap required to ascertain the goods or services offered under a mark need not be an enormous leap in order for the mark to be deemed suggestive. For example, the mark SEATS used for a ticket reservation system for concert seating was determined not to be merely descriptive. *In re Seats, Inc.*, 757 F.2d 274 (D.C. Cir 1985). In addition, the TTAB rejected the Examining Attorney's reliance on definitions of the terms comprising the mark in finding that SNO-RAKE was not merely descriptive when used in relation to a hand tool—essentially, a rake—used to scrape off or remove snow. *See In re Shutts*, 217 USPQ 363 (TTAB 1983). In *In re Hester Industries, Inc.*, 230 USPQ 797 (TTAB 1986), the TTAB held that the words "THIGH" and "STIX" were not merely descriptive of applicant's boneless chicken parts. The TTAB stated that although the word "THIGH" may have described a principal ingredient of

applicant's goods, the word "STIX," at most, was suggestive of applicant's goods so that the combination thereof created a suggestive, rather than a descriptive, term. *See also, In re Geo. A. Hormel & Co.*, 218 USPQ 286 (TTAB 1983) (the combination of the terms FAST 'N EASY was deemed suggestive of fast-cooked meat products).

A trademark is merely descriptive only if it ***immediately*** informs ordinary purchasers of the purposes or functions of the goods or services ***with a degree of particularity***. *See, e.g., Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247 (Fed. Cir. 2012); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Entennman's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd* 90–1495 (Fed. Cir. 1991). If a mark causes consumers to pause, even for a moment, in order to determine the exact nature of the goods or services, then the mark is suggestive. *See, Equine Tech., Inc. v. EquineTechnology, Inc.*, 36 USPQ2d 1659 (Fed. Cir. 1995). The categories of "suggestive" and "merely descriptive" are part of a spectrum, and are often very difficult to apply. *In re Gyulay,* 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

II. Grounds for Appeal

This argument focuses on four elements that indicate the Applicant's Mark is at least suggestive and distinctive, including:

A. The Applicant's Mark is suggestive because it requires imagination, thought and perception on the part of the purchaser to understand the nature of Applicant's Goods.

B. The Applicant's Mark is a double entendre, and double entendres are not merely descriptive under Section 2(e) of the Trademark Act.

C. The term "rapid" is frequently deemed at least suggestive by the USPTO in the computer software field and other contexts, and the Applicant's Mark should be treated similarly to those third party marks.

D. The Examining Attorney bears the burden of establishing that Applicant's Mark is descriptive, and the Examining Attorney has not met this burden.

Each of these elements alone, and certainly all of them collectively, make clear that the Applicant's Mark is not merely descriptive of Applicant's Goods, but is, in fact, at least suggestive and distinctive and therefore registrable on the Principal Register. Consequently, the Applicant requests that the Applicant's Mark be approved for publication.

A. <u>The Applicant's Mark is Suggestive Because it Requires Imagination, Thought and Perception on the Part of the Purchaser to Understand the Nature of Applicant's Goods.</u>

Applicant's Mark is suggestive of the goods on which it is used because it requires imagination, thought and perception on the part of the purchaser to understand the nature of Applicant's Goods. Purchasers need to make a mental leap between "RAPID" to computer software designed to "enable users to configure, control and analyze line performance from a standard operator station."[7] The purpose or function of the Applicant's Goods is to create a common equipment interface, which enables manufacturers to more easily and economically commission new manufacturing lines or upgrade a line more efficiently. The goal of the Applicant's Goods is to limit the amount of downtime. The goal is **not** to run "fast" software programs or to even increase the speed of the manufacturing line or the integration time.

The Examining Attorney has reviewed Applicant's website and other evidence and found minor and isolated references to "faster" in concluding that the Applicant's Mark is merely descriptive. However, these minor references are not taken in their proper context, with the Examining Attorney erroneously concluding that the Applicant's Goods are described as "functioning in a fast or rapid manner."

[7] See Exhibit A, to October 14, 2015 Response to Office Action.

While Applicant's Goods "can be implemented faster than most traditional methods" of line integration, this does not properly describe the goods, their function, or their purpose as required for a descriptive mark. Instead, Applicant's Goods are used to optimize a manufacturing line with a simplified, repeatable interface across all equipment which provides the ability to produce reliable and real-time reporting for performance and to identify manufacturing issues.

Clearly, Applicant's Mark is not immediately descriptive. As prior cases have stated, the mental leap is not required to be enormous to be deemed a suggestive mark. Here, as in the cases cited above, prospective purchasers must use imagination, thought and perception to understand the nature of Applicant's Goods and the purpose for which they are sold.

B. The Applicant's Mark is a Double Entendre, and Double Entendres Are Not Merely Descriptive Under Section 2(e) of the Trademark Act.

Applicant's Mark conveys a unique and special meaning as applied to the Applicant's Goods. The term RAPID also refers to **R**ockwell **A**utomation for **P**erformance, **I**ntegration and **D**ata. Applicant's Goods are uniquely focused on the ability to improve *performance* and provide real-time and historical *data* for line *integration*. In this way, the term RAPID has a novel and suggestive meaning as applied to Applicant's Goods and is not merely descriptive. This additional meaning only further demonstrates that the Applicant's Mark is at least suggestive and registrable on the Principal Register.

Double entendres, namely marks that convey a dual meaning, are not merely descriptive under Section 2(e) of the Act. *See, Henry Siegel Co. v. M&R International Mfg. Co.*, 4 USPQ2d 1154 (TTAB 1987). In *Henry Siegel Co.*, the mark "CHIC" as applied to women's jeans had a dual meaning of both a slang term for a woman and being fashionable. Because the mark conveyed a dual meaning, it was held to be not "merely descriptive" under Section 2(e).

Dual meanings do not have to be particularly clever or witty. For example, 100% TIME RELEASE MOISTURIZER was deemed suggestive based on three possible interpretations: "(1) this bottle contains nothing but time release moisturizer, (2) this product moisturizes 100% of the time, and (3) this is 100% (the brand) time release moisturizer." *Estee Lauder Inc. v. The Gap, Inc.*, 932 F. Supp. 595, 609 (SDNY 1996), *rev'd on other grounds* 108 F.3d 1503 (2d Cir. 1997). Similarly, the TTAB concluded that CHABLIS WITH A TWIST has "a suggestive dual meaning of Chablis wine flavored with a citrus peel or Chablis wine with some attribute that is unusual or unexpected in some way." *Institut National des Appellations d'Origine des Vins et Eaux-de-Vie v. Vintners International Co.*, Opp. No. 81,742 (TTAB Mar. 19, 1991). In yet another case, the TTAB recognized that use of a double entendre requires use of imagination and therefore renders THE DRIVING FORCE mark at least suggestive when used in respect of "supplying leased drivers and goods," with the mark describing both the services provided and that the owner was "a leader in the industry." *Manpower, Inc. v. The Driving Force, Inc.*, 212 USPQ 961, 963 (TTAB 1981); *See also, Application of Colonial Stores, Inc.*, 394 F.2d 549 (CCPA 1968) (holding that the mark SUGAR & SPICE as used on bakery products was not descriptive because it also brought to mind the phrase "sugar and spice and everything nice" which "results in a unique and catchy expression which does not, without some analysis and rearrangement of its components suggest the contents of applicant's goods").

The "RAPID" term similarly conveys a dual meaning, excluding it from consideration as a descriptive mark. Applicant has developed an innovative approach and significant enhancement to line integration, which is a major development and improvement to manufacturing processes across many industries. Some might describe this new development as

"cool" or "excellent." And, in fact, the slang definition for RAPID is actually "cool; excellent."[8] This dual meaning of "fast" and "cool" as applied to the term "RAPID" in connection with Applicant's Goods creates a double entendre that cleverly relates to Applicant's Goods. As such, Applicant's Mark is not merely descriptive, but at least suggestive of Applicant's Goods.

C. The Term "RAPID" is Frequently Deemed at Least Suggestive By the USPTO in the Computer Software Field and Other Contexts, and Applicant's Mark Should Be Treated Similarly to Those Third Party Marks.

Use of the term "rapid" is frequently deemed at least suggestive by the USPTO when appearing in marks used on computer software and other goods. In many of these contexts, the term "rapid" similarly refers to an improved or faster process or service, much like Applicant's Mark. All of these third party marks containing the word "rapid" have been deemed suggestive and have been registered on the Principal Register without a disclaimer or a claim of distinctiveness. The following third party marks provide a listing of some of these marks.[9]

Mark	Registration Number	Goods
RAPID SOLAR DEPLOYMENT	4646908	Augmented reality software for use in mobile devices for integrating electronic data with real world environments for the purpose of generating a geometrically accurate digital representation of the positional relationships between solar panels and a roof; Computer software, namely, software for measuring and assembling exterior features of a roof using aerial imagery, photographic data, real-time imagery, and geographic information; Computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; Computer software, namely, an application allowing field service employees to update and receive data stored in an enterprise's computer databases in real time, using a mobile device, with full telephony integration with the telephone and/or software features of the mobile device; downloadable software for computers, portable handheld digital electronic communication devices, mobile devices, wired and wireless communication devices which provides real-time image recognition and displays augmented reality graphics; Computer software for business automation,

[8] See Exhibit B, October 14, 2015 Response to Office Action.
[9] See, Exhibit C to the October 14, 2015 Response to Office Action.

Mark	Registration Number	Goods
		namely for managing and tracking projects, performing logistics functions, tracking inventory, and generating reports in the field of construction; computer software for tracking, allocating and reporting costs associated with the use of building construction components
RAPID TRANSFORMATION	3100474	Technical consulting services to improve the manufacturing processes for chemicals, crude substances, textiles, foods, fragrances and energy
RAPID SOLUTIONS TO 3D PROBLEMS	3040510	Computerized engineering services, namely three-dimensional measuring, analyzing, digitizing, scanning, digital modeling and reverse engineering; integration of computer hardware and software for purposes of product development, industrial design, historic preservation, manufacturing and replication; product research and development in the area of three-dimensional measuring, analyzing, digitizing, scanning, digital modeling and reverse engineering
RAPID LEGAL FILE & SERVE SOLUTIONS	3233341	Legal services, namely document preparation for others, process serving, filing of documents in court, filing of legal documents by fax, filing of legal documents electronically, and legal services in support of litigation
RAPID CYCLE	1831933	Computer programs for continuous flow manufacturing line analysis.
RAPID CYCLE TIME	3958677	On-line ordering services in the field of electric power distribution cables; Customer service related to the on-line ordering of electric power distribution cables
RAPID RESPONSE	4779131	Employment agency services, namely, temporary and permanent placement of healthcare professionals
RAPID GROW	4813642	Agricultural seeds, namely, grass seed and forage seed
LIFESAFETY MONITORING A DIVISION OF RAPID RESPONSE	4824809	Emergency response medical alarm monitoring services **[*Note* that terms other than RAPID are disclaimed in this registration but not RAPID. It is hard to imagine any other time when RAPID would not mean "fast" in the context of emergency response services.]**

Applicant's Mark should be treated similarly to the third party marks discussed above. These other registrations further demonstrate that RAPID is not automatically viewed as meaning "fast" in a trademark context. Arguably, RAPID has less descriptive meaning as applied to Applicant's Goods than many of the registrations identified above, such as RAPID RESPONSE for emergency response medical alarm monitoring services. Based on the treatment

of third party marks, Applicant's Mark should also be deemed suggestive and entitled to registration on the Principal Register.

D. The Examining Attorney Bears the Burden of Establishing That Applicant's Mark is Descriptive, and the Examining Attorney Has Not Met this Burden.

The Examining Attorney bears the burden of establishing that the Applicant's Mark is merely descriptive. The Applicant is required only to make the issue of whether the Mark is, at least suggestive of its goods or services an open question in order for the Mark to be registered. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). Because it is a fine line between a merely descriptive mark and a suggestive mark, the TTAB takes the position that any doubt is resolved in favor of the applicant—as any potential competitors will have ample opportunity to oppose the registration of applicant's mark during the publication period. *See In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB. 1972). Since the question as to whether Applicant's Mark is suggestive remains open, the Examining Attorney's initial refusal should be reversed.

SUMMARY

The Examining Attorney has argued that Applicant's Mark is merely descriptive of the Applicant's Goods provided under the Mark. However, the Examining Attorney's arguments fail to meet the burden of proving that the world "RAPID" as applied to Applicant's Goods, is merely descriptive. In considering this issue, the Examining Attorney has failed to consider the suggestive nature of the Applicant's Mark. The Applicant's Mark requires imagination, thought and perception on the part of the purchaser to understand the nature of Applicant's Goods. The Examiner has also failed to recognize that Applicant's Mark is a double entendre, and double entendres, namely marks that convey a dual meaning, are not merely descriptive under Section 2(e) of the Act. Moreover, the Examining Attorney has failed to consider that the usage of the

term "rapid" is frequently deemed at least suggestive by the USPTO in the computer software field, and that Applicant's Mark should be treated similarly to those third party marks. The Examining Attorney has also failed to recognize that she bears the burden of establishing that the Applicant's Mark is merely descriptive. In short, the Examining Attorney's evidence and arguments do not establish that the Applicant's Mark is merely descriptive of the features and subject matter of the Applicant's Goods provided under the Mark.

Consequently, Applicant asserts that Applicant's Mark should be deemed suggestive and registrable on the Principal Register. Because all formal requirements are in order, Applicant respectfully requests the Applicant's Mark be approved for publication

Respectfully submitted,

Elisabeth Townsend Bridge

Elisabeth Townsend Bridge
Attorney for Applicant

Alphabetical Index of Cited Cases